

REMARKS

Claims 1-49 are pending in the application with claims 22-35 currently under examination. Claims 1-21 and 36-49 have previously been withdrawn from consideration as being directed to a non-elected invention. Without acquiescing in the rejection, and for the sole purpose of expediting prosecution, claims 22, 24 and 30 have been amended without prejudice to Applicants pursuing these claims in their original forms in a related application. Support for the amendments can be found throughout the application as filed and at, for example, page 49, lines 8-14; page 18, lines 8-15 and page 19, lines 11-16. Accordingly, the amendments do not raise an issue of new matter and entry thereof is respectfully requested. Applicant has reviewed the rejections set forth in the pending Office Action, and respectfully traverse all grounds for the reasons that follow.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 22-35 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite allegedly because they recite the phrase “said determination of said multidimensional coordinate point.” Applicants have amended claims 22, 24, and 30 to particularly point to the antecedent of the “said determination.” Accordingly, the ground of rejection is moot in claims 22, 24, and 30, as well as in their dependent claims 23, 25-29, and 31-35, and withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 22-35 under 35 U.S.C. § 102(b) stand rejected as allegedly anticipated by Stoughton et al. (U.S. Patent No. 6,132,969) for reasons stated at pages 3-8 of the Office Action. In particular, the Office maintains its contention that positional addressable transcript microarrays wherein graded drug exposure and graded levels of modification or perturbation are measured describe a multidimensional coordinate point because the “microarrays inherently involve mRNA locations containing x and y dimensions (multidimensional coordinate points) for components of a physically perturbed system including n parameters (i.e. drug exposure and levels of perturbation) corresponding to the number of measured components within the biochemical system, as stated in instant claim 22, 24 and 30.” Office Action at page 3, last line

to page 4, line 8. For the reasons of record and further as set forth blow, Applicants respectfully traverse this rejection for at least the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 9Fed. Cir. 1987)) (emphasis added). A rejection under 35 U.S.C. § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); MPEP § 706.02.

The Office has failed to establish that each and every element of the claims is either expressly or inherently described in Stoughton et al. Specifically, claims 22 —and similarly claims 24 and 30— as amended recite the following:

...determining a multidimensional coordinate point consisting of a statistically characterized data element of one or more components of a perturbed biochemical system,

The recited multidimensional coordinate point is further qualified as follows:

said multidimensional coordinate point including values for n parameters integrated in n-dimensional space wherein n corresponds to the number of measured biochemical components within a biochemical or constituent system;... (emphasis added)

Figures 1-2 of the application, further illustrate the claimed multidimensional coordinate points. For example, Figure 2 shows the coordinate points in a two-dimensional space and Figure 1 shows the coordinate points in a three-dimensional space. See Figure descriptions on pages 5 and 6.

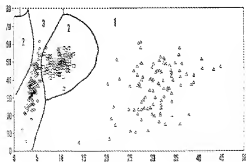


Figure 2

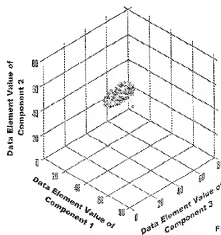


Figure 1

Each of the multidimensional coordinate points in the above n-dimensional spaces is statistically characterized as indicated on page 49, lines 8-14 of the application using the statistical methods and algorithms described in preceding pages 44-49.

Unlike the microarray spots with their inherent x and y dimensions as allegedly disclosed in Stoughton et al., each of the multidimensional coordinate points presently claimed consists of a statistically characterized data element. A data element is a value, an analytical representation, as defined by the specification on page 28, line 27 to page 29, line 2. A data element, therefore, cannot be a physical location like a microarray spot. Accordingly, the Office fails to show that Stoughton et al. either expressly or inherently teaches the element of “a multidimensional coordinate point consisting of a statistically characterized data element.”

Furthermore, claims as amended are directed to multidimensional coordinate points containing n parameters integrated in n-dimensional space whereas Stoughton et al. in col. 52, lines 1-17, merely describes separate measurements obtained from microarrays for graded drug exposure and graded levels of the perturbation. Stoughton et al. throughout the disclosure remain silent as to whether such separately measured parameters are integrated in n-dimensional space. In this regard, Stoughton et al. fails to describe the claimed multidimensional coordinate point that includes values of n parameters integrated in n-dimensional space. Accordingly, the Office fails to show that that Stoughton et al. either expressly or inherently teaches the element of “values for n parameters integrated in n-dimensional space.”

Without addressing the merits of other contentions made by the Office and in view of the claim amendments and arguments presented above, Applicants aver that the Office fails to establish that Stoughton et al. teaches each and every element of the claims, either expressly or inherently. Applicants, therefore, respectfully request that this rejection be withdrawn.

CONCLUSION

In light of the Remarks herein, Applicants submit that the claims are in condition for allowance and respectfully request a notice to this effect. Should the Examiner have any questions, she is invited to call the undersigned attorney.

10/062,299

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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